

REMARKS

Claims 1-17 are pending in the application. Pursuant to the Restriction Requirement, claims 7-17 have been withdrawn from consideration. Thus, claims 1-6 are the only claims that have been examined in the current Office Action. Claims 1-2 and 4-5 have been rejected under 35 U.S.C. § 102, and claims 1-6 have been rejected under 35 U.S.C. § 103.

Preliminary Matters

The Examiner has objected to claim 1 due to a minor informality. Accordingly, Applicant has amended claim 1, and submits that such amendment overcomes the objection. The Examiner has also suggested a minor amendment to claim 1 for clarification purposes. Accordingly, Applicant has amended claim 1 in a similar manner as suggested by the Examiner. Such amendment is for clarification purposes, and is not made in view of any prior art. Since claim 1 was amended for clarification purposes, Applicant also made a minor amendment to claim 5 for clarification purposes, and to avoid an antecedent basis error.

Rejections under 35 U.S.C. § 102

1. Claims 1, 2, 4 and 5 have been rejected under 35 U.S.C. § 102(b) as being anticipated over U.S. Patent No. 4,620,184 to Nedstedt ("Nedstedt"). As noted on page 2 of the present Office Action, the Examiner maintains the rejections as set forth in the December 4, 2002 Office Action.

A. Claim 1

Regarding claim 1, the Examiner maintains that the function of the target is not given patentable weight since claim 1 is an apparatus claim. However, Applicant submits that claim 1 recites structure rather than an intended use. Therefore, Applicant submits that patentable weight must be given to the claimed configuration.

Claim 1 recites a target disposed in a hollow portion of a sheet roll cartridge. The target is configured to provide information to identify the type of the sheet roll cartridge.

The Examiner maintains that Nedstedt discloses such a feature. In particular, the Examiner maintains that field generating element 11 discloses the claimed target (Fig. 1; col. 2, lines 58-60). However, contrary to claim 1, field generating element 11 is not configured to provide information to identify the type of the sheet roll. Rather, as disclosed in the reference, field generating element 11 is used to determine when a material web 1 of material roll 3 is consumed (col. 3, lines 13-30). Applicant submits that the determination of when a roll is consumed, or in need of replacement, fails to teach or disclose a target configured to provide information for identification of a type of sheet roll.

In addition, although claims 1, 2, 4 and 5 have been rejected under 35 U.S.C. § 102(b), on page 4 of the present Office Action, the Examiner recites an obviousness type rejection. In particular, the Examiner maintains that it would be within the realm of one skilled in the art to use the field generating element 11, as taught by Nedstedt, for determining the identification of the material roll 3.

However, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988, emphasis added). Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. *In re Kotzab*, 55 USPQ2d at 1316-1317; see also MPEP § 2142 (quoting *Ex parte Clapp*, 227 USPQ 972, 973 (B. Pat. App. & Inter. 1985)) (“To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.”).

Applicant submits that there is no suggestion in Nedstedt of a need (i.e. suggestion or motivation) to identify a type of material roll 3, or to modify field generation element 11. Therefore, Applicant submits that it would not have been obvious for one of ordinary skill in the art to somehow modify the field generating element 11 of Nedstedt so that it can determine the identity of the material roll 3.

B. Claims 2 and 4

Since claims 2 and 4 are dependent upon claim 1, Applicant submits that such claims are patentable at least by virtue of their dependency.

C. Claim 5

Since claim 5 is dependent upon claim 1, Applicant submits that such claim is patentable at least by virtue of its dependency.

In addition, claim 5 recites that the target is located at one of a plurality of predetermined positions. On page 7 of the present Office Action, the Examiner maintains that the field generating element 11 of Nedstedt is located at the center, which is a predetermined position. However, assuming the center position is a “predetermined” position, the reference still fails to teach or disclose a plurality of predetermined positions. Accordingly, Applicant submits that claim 5 is patentable over the cited reference.

2. Claims 1, 2, 4 and 5 have been further rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,984,049 to Lammers (“Lammers”). As noted on page 3 of the present Office Action, the Examiner maintains the rejections as set forth in the December 4, 2002 Office Action.

A. Claim 1

Applicant submits that claim 1 is patentable over the cited reference. For example, claim 1 recites a target disposed in a hollow portion of a sheet roll cartridge, which is configured to provide information to identify the type of the sheet roll cartridge.

The Examiner maintains that Lammers discloses such a feature. In particular, the Examiner maintains that the signal generating means discloses the claimed target (Figs. 1 and 2;

col. 3, lines 16-36). However, contrary to the Examiner's assertion 1, the signal generating means is not configured to provide information to identify the type of the roll 1. Rather, as disclosed in the reference, the signal generating means is used to generate audio signals, noise or the like (col. 3, lines 31-37 and col. 3, line 66-col. 4, line 5). Applicant submits that a signal generating means configured to generate audio signals, or noise, fails to teach or disclose a target configured to provide information for identification of a type of roll 1 (i.e. sheet roll cartridge of claim 1).

Accordingly, since Lammers fails to teach or disclose each and every feature recited in claim 1, Applicant submits that such claim is patentable over the cited reference.

B. Claims 2 and 4

Since claims 2 and 4 are dependent upon claim 1, Applicant submits that such claims are patentable at least by virtue of their dependency.

C. Claim 5

Since claim 5 is dependent upon claim 1, Applicant submits that such claim is patentable at least by virtue of its dependency.

In addition, claim 5 recites that the target is located at one of a plurality of predetermined positions. Lammers fails to teach or suggest that the signal generating means, which includes a bellows device 5 and elastic braces 6, is located at one of a plurality of predetermined positions.

Rather, the reference just states that bellows device 5 is arranged inside the cavity formed by roll core 2, and is connected to the elastic braces 6 (col. 3, lines 17-27). The disclosure of being arranged “inside the cavity” fails to teach or disclose a plurality of predetermined positions, as required by claim 5. Accordingly, Applicant submits that claim 5 is patentable over the cited reference.

Rejections under 35 U.S.C. § 103

Claims 1-6 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Nedstedt in view of U.S. Patent No. 4,852,823 to Adams et al. (“Adams”). As noted on page 3 of the present Office Action, the Examiner maintains the rejections as set forth in the December 4, 2002 Office Action.

Applicant submits that claims 1-6 are patentable over the combination of the cited references. On page 7 of the present Office Action, the Examiner maintains that insert 41 of Adams could be added to the Nedstedt device so that material on the Nedstedt device is distinguishable from other similar devices with different sheet material. However, “[o]bviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.” *In re Geiger*, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987) (citing *ACS Hosp. Sys. v. Montefiore Hosp.*, 221 USPQ 929, 933 (Fed. Cir. 1984)). Applicant submits that the Examiner’s use of hindsight fails to provide the necessary teaching, suggestion or incentive in either reference.

Specifically, there is no suggestion or incentive to provide the insert 41 of Adams into the material roll 3 of Nedstedt.

In addition, even if combined, the combination of the cited references fail to teach or disclose the claimed target. For example, Adams discloses that insert 41 helps to catch the end of yarn, as well as identify characteristics of the yarn (i.e. color) (Abstract; col. 3, lines 20-47). Therefore, insert 41 of Adams (Fig. 5) fails to cure the deficient teachings of Nedstedt.

Also, similar to Applicant's statements above, the determination of when a roll is consumed or in need of replacement, as taught in Nedstedt, fails to teach or suggest a target configured to provide information for identification of a type of sheet roll cartridge. Therefore, Applicant submits that neither Nedstedt or Adams even remotely suggest the claimed target.

In addition, claim 5 recites that the target is located at one of a plurality of predetermined positions. On page 7 of the present Office Action, the Examiner maintains that the field generating element 11 of Nedstedt is located at the center, which is a predetermined position, and the insert 41 of Adams is positioned at the end of a core, which is a predetermined position. However, assuming the center position of Nedstedt is a "predetermined" position and the end position of Adams is a "predetermined" position, each reference still fails to teach or disclose a plurality of predetermined positions. Since there is no suggestion or incentive to combine Nedstedt and Adams, or to modify the field generating element 11 of Nedstedt with the insert 41 of Adams, it is improper to combine the placement of each of the features and summarize that a plurality of predetermined positions is thus shown. Therefore, Applicant submits that the position of two completely independent features of two different references fail to suggest the

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claimed plurality of predetermined positions. Thus, Applicant submits that claim 5 is patentable over the cited references.

Accordingly, Applicant submits that claims 1-6 are patentable over the cited references.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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